

## **REMARKS**

Applicants thank the Examiner for the thorough examination given the present application.

### **Status of the Claims**

Claims 1-14 are pending in the above-identified application. Claim 1 has been amended. Support for the recitations in claim 1 can be found in the present specification, *inter alia*, at pages 1 and 5-6. Thus, no new matter has been added.

Applicants submit that the present Amendment is merely formal in nature, reduces the number of issues under consideration, and places the case in condition for allowance. Alternatively, entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

### **Issues under 35 U.S.C. § 102(b)**

Claims 1, 6, and 9 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Hara et al. (Flower Induction in Asparagus Seedlings by Anilide and Benzamide Derivatives, *J. Agric. Food Chem.*, 40, 1992, pages 1692-1694). Applicants respectfully traverse. Reconsideration and withdrawal of the outstanding rejection are respectfully requested based on the following considerations.

Hara et al. describe flower induction in asparagus seedlings by anilide compounds. In stark contrast to the compounds of formula I of the present invention, the anilide compounds of Hara et al. do not carry a phenyl ring as a substituent on the anilide moiety or, more specifically, a substituted phenyl ring which is located in the 2-position of the anilide moiety. Consequently, Hara et al. fail to anticipate any of the present claims such that the above-noted anticipation rejection based on this reference must be withdrawn.

Accordingly, the present invention is not anticipated by Hara et al. since the reference does not teach or provide for each of the limitations recited in the pending claims.

For completeness, Applicants also respectfully submit that Hara et al. do not render the present invention obvious because neither the reference nor the knowledge in the art provides any disclosure, reason, or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed.

**Issues under 35 U.S.C. § 103(a)**

1) Claims 1-11 and 14 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Eicken et al. '745 (US 6,143,745).

2) Claims 12-13 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Eicken et al. '745 in view of Asrar et al. '371 (US 2003/0060371).

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested based on the following considerations.

Eicken et al. '745 describe carboxanilide compounds and their use for controlling harmful fungi. However, a growth regulating action is not described. The Examiner asserts that one of ordinary skill in the art would assume that plants in need of treatment against fungi are in need of growth promotion since the plants would be destroyed if the plants are not treated against the harmful fungi.

However, the compounds of formula I are not limited to a pesticidal action for exerting a growth regulating effect. Rather, the compounds of formula I incite or promote plant responses which are completely different from Eicken et al. '745. The present specification states that the growth regulation process means "a variety of plant responses which attempt to improve some characteristic of the plant as distinguished from pesticidal action" (page 1, lines 8-14; emphasis added). The present specification also states that the compounds of formula I may also be applied to the soil, wherefrom they are root-absorbed and result in plant responses which correspond to growth regulation (page 14, lines 37-41). Furthermore, Example 1 proves that the growth regulating effect was achieved, as compared to untreated onion plants, although no fungal diseases were present (page 15, lines 4-13).

In other words, according to Eicken et al. '745, the compounds described therein are only applied to the plants when there is a current or expected pest pressure. In the method of the present invention, the carboxamides are also applied to the plants when there is no expected pest pressure because the expected benefits of improved growth are completely different from the control of fungi.

Applicants have defined growth promotion in a specific way which distinguishes the method of the present invention from pesticidal action. MPEP 2111.01(IV) states, "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claims." As such, Eicken et al. '745 do not teach the growth regulating action of the compounds of formula I of the present invention.

The Examiner acknowledged the above argument in the outstanding Office Action but did not consider it persuasive. Specifically, the Examiner argued that the claims do not make this distinction as currently written. As amended, independent claim 1 now recites, *inter alia*, "A method for **regulating plant growth...**" (emphasis added). As such, the claims now clearly make a distinction between plant growth and the control of fungi.

As discussed above, Eicken et al. '745 do not disclose each and every aspect of the pending claims. Specifically, Eicken et al. '745 fail to teach the growth regulating action of the compounds of formula I of the present invention. Regarding the second rejection under 35 U.S.C. § 103, Applicants respectfully submit that Asrar et al. '371 do not overcome the deficiencies of this reference.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, Eicken et al. '745 with or without Asrar et al. '371 fail to disclose all of the claim limitations of independent claim 1, and those claims dependent thereon. Accordingly, the combination of references does not render the present invention obvious. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

**CONCLUSION**


A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1-14 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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